II.   REMARKS

A.   Front Page of Office Action

The cover page of the office action indicates that claims 1-65 are pending in the application and that claims 1-65 are rejected.

B.   Status of Claims

Claims 1-65 are cancelled.

Claims 66-88 are new.

Claims 66, 75, 87, and 88 are the independent claims.

C.   The Rejections of Claims 1-5, 7-21, 23-37, 39-46, and 59-65 Under 35 USC 102(e) as Being Anticipated by Kepecs USP 7,552,069 hereinafter "Kepecs"); and the Rejections of Claims 6, 22, 38, and 47-58 Under 35 USC 103(a) as Being Unpatentable Over Kepecs are Improper Because the Subject Application's Pre-Filing Documents Antedate Kepecs

The examiner has rejected claims 1-5, 7-21, 23-37, 39-46, and 59-65 under 35 USC 102(e) as being anticipated by Kepecs; and has rejected claims 6, 22, 38, and 47-58 under 35 USC 103(a) as being unpatentable over Kepecs.

In response, the applicant submits that Kepecs is not prior art under 35 USC 102(e). The applicant submits herewith documentation showing (1) conception of the invention and corroborating evidence of a contemporaneous disclosure that would enable one skilled in the art to make the invention prior to the December 22, 2000 102(e) priority filing date of Kepecs and (2) diligence in reducing the invention to practice, culminating in the February 6, 2001 filing date of the subject application.

Attachment 1 is a copy of a November 21, 2000 email from John Conroy, a patent attorney at Oblon, Spivak, McClelland, Maier & Neustadt, P.C., the firm that filed the subject application, to John Halak, vice president of legal affairs for Catalina Marketing Corporation, the assignee of the subject application, which further contains email attachments comprising a draft of the written description, claims, and drawings [the November 21, 2000 specification]. The November 21, 2000 specification is are also included in Attachment 1. The November 21, 2000 specification discloses every limitation in every new claim (claims 66-88) in the subject

application. The November 21, 2000 specification antedates Kepecs.

Attachments 2-11 contain a number of emails dating from December 4, 2004 until January 31, 2001, between and involving the following parties: Carol Chapman (now Carol Warren), a legal assistant at Catalina Marketing Corporation during the relevant period; John Halak, vice president of legal affairs for Catalina Marketing Corporation during the relevant period; Gary Katz, the inventor of the subject application, and the following three patent attorneys at Oblon, Spivak, McClelland, Maier & Neustadt, P.C. during the relevant period: John Conroy, Robert Mattson, and Rick Neifeld. This email correspondence evidences due diligence to a subsequent reduction to practice with the February 6, 2001 filing of the application.

Attached herewith is a 37 CFR 1.131 declaration of attorney of record Bruce T. Margulies, attesting that the email documentation which comprise Attachments 1-11 submitted herewith are true and accurate copies of emails sent to Bruce T. Margulies by Carol Warren (formerly Carol Chapman), who had access of the original emails.

Attached herewith is a 37 CFR 1.131 declaration of Carol Warren, attesting that the email documentation which comprise Attachments 1-11 submitted herewith are true and accurate copies of the original emails.

The table beginning on the following page indicates the location in the November 21, 2000 specification of the disclosure of every limitation in every newly added claim in the subject application.

Limitational Recitation in Claims of Subject Application	Citation of Support in Nov. 21, 2000 Specification which Antedates Kepecs
66. A computer-implemented method comprising steps of:	**Page 3 lines 15-16; Figure 10 element 801.**
receiving, using an identification input device designed to receive identification information, a first consumer identification for a first consumer;	**Page 8 lines 10-11; Figure 1 element 638; Figure 6 element 6100.**
identifying, using a processor, promotions offered to said first consumer, by retrieving from a central database system in which consumer identifications are associated with promotion offers data for promotions previously offered to consumers, first consumer promotions offer data associated with said first consumer identification for promotions previously offered to said first consumer;	**Page 6 lines 19-22; Page 16 lines 2-6; Figure 4a element 730; Page 9 lines 16-19; Figure 1 elements 613, 614.**
determining, using said processor, and based at least in part upon said first consumer promotions offer data, a first consumer demographic characteristic of said first consumer; and	**Page 9 lines 16-19; Figure 1 elements 615, 616, 617; Figure 3b element 720; Page 14 lines 24-25; Figure 3a element 710e; Figure 7 element 6200.**
determining, using said processor, and based at least in part upon said first consumer demographic characteristic, a time at which to transmit to said first consumer a subsequent promotion offer.	**Page 9 lines 19-21; Figure 1 elements 613, 615, 616, 617; Page 11 lines 26-30; Figure 2 elements 644, 646; Page 16 lines 1-2; Figure 4a element 730; Page 19 lines 11-12; Figure 7 element 6300; Page 14 lines 28-29; Figure 3a element 710e.**
67. The method according to claim 66, wherein said time is also based upon the desirability of said first consumer to a promoter.	**Page 3 lines 27-29. Page 14 lines 21-24.**
68. The method according to claim 66, wherein said time is also based upon the purchase history of said first consumer.	**Page 3 line 27 through page 4 line 2.**
69. The method according to claim 66, wherein said time is also based upon the promotion redemption history of said first consumer.	**Page 17 lines 16-21; Figure 5 element 750, Figure 1 element 616.**
70. The method according to claim 66, wherein said subsequent promotion is delivered to an address associated with said first consumer.	**Page 11 lines 19-22; Figure 1 elements 643, 644, 646.**
71. The method according to claim 66, wherein said address is an Internet protocol address.	**Page 27 line 14.**
72. The method according to claim 66, wherein said identification input device is a personal computer operated by said consumer.	**Page 7 lines 24-25; Figure 1 element 630.**

73. The method according to claim 66, wherein said time is also based upon the value of said subsequent promotion offer.	**Page 15 lines 9-11; Figure 3a element 710g.**
74. The method according to claim 66, wherein said time is also based upon the provision method of a prior promotion offer.	**Page 19 line 16.**
75. A computer-implemented method comprising steps of:	**Page 3 lines 15-16; Figure 10 element 801.**
receiving, using a request input device designed to receive consumer target parameters, a first consumer target parameter;	**Page 11 lines 10-18; Figure 1 elements 610, 620, 640, 643, 646, 680, 682.**
receiving, using an identification input device designed to receive identification information, a first consumer identification for a first consumer;	**Page 8 lines 10-11; Figure 1 element 638; Figure 6 element 6100.**
identifying, using a processor, promotions offered to said first consumer, by retrieving from a central database system in which consumer identifications are associated with promotion offers data for promotions previously offered to consumers, first consumer promotions offer data associated with said first consumer identification for promotions previously offered to said first consumer;	**Page 6 lines 19-22; Page 16 lines 2-6; Figure 4a element 730; Page 9 lines 16-19; Figure 1 elements 613, 614.**
determining, using said processor, and based at least in part upon said first consumer promotions offer data, a first consumer demographic characteristic of said first consumer; and	**Page 9 lines 16-19; Figure 1 elements 615, 616, 617; Figure 3b element 720; Page 14 lines 24-25; Figure 3a element 710e; Figure 7 element 6200.**
if said first consumer target parameter for a first consumer matches said first consumer demographic characteristic of said first consumer, determining, using said processor, and based at least in part upon said first consumer demographic characteristic, a time at which to transmit to said first consumer a subsequent promotion offer.	**Page 9 lines 19-21; Figure 1 elements 613, 615, 616, 617; Page 11 lines 26-30; Figure 2 elements 644, 646; Page 16 lines 1-2; Figure 4a element 730; Page 19 lines 11-12; Figure 7 element 6300; Page 14 lines 28-29; Figure 3a element 710e.**
76. The method according to claim 75, wherein said time is also based upon the desirability of said first consumer to a promoter.	**Page 3 lines 27-29. Page 14 lines 21-24.**
77. The method according to claim 75, wherein said time is also based upon the purchase history of said first consumer.	**Page 3 line 27 through page 4 line 2.**
78. The method according to claim 75, wherein said time is also based upon the promotion redemption history of said first consumer.	**Page 17 lines 16-21; Figure 5 element 750, Figure 1 element 616.**
79. The method according to claim 75, wherein said subsequent promotion is delivered to an address associated with said first consumer.	**Page 11 lines 19-22; Figure 1 elements 643, 644, 646.**
80. The method according to claim 75,	**Page 27 line 14.**

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wherein said address is an Internet protocol address.	
81. The method according to claim 75, wherein said identification input device is a personal computer operated by said first consumer.	**Page 7 lines 24-25; Figure 1 element 630.**
82. The method according to claim 75, wherein said time is also based upon a promoter providing a desired number of promotions during a particular time period.	**Page 3 lines 24-25.**
83. The method according to claim 75, wherein said time is also based upon a retail store providing a desired number of promotions during a particular time period.	**Page 3 lines 24-25.**
84. The method according to claim 75, wherein said time is also based upon the desirability of said first consumer to a retail store.	**Page 17 lines 24-29.**
85. The method according to claim 75, wherein said time is also based upon the value of said subsequent promotion offer.	**Page 15 lines 9-11.**
86. The method according to claim 75, wherein said time is also based upon the provision method of a prior promotion offer.	**Page 19 line 16.**
87. A system, comprising: an identification input device at a vendor interaction computer configured to receive a first consumer identification for a first consumer;	**Page 8 lines 10-11; Figure 1 element 638; Figure 6 element 6100.**
a central database comprising a consumer identification table and a promotion table;	**Page 15 line 29 through Page 16 line 6; Figure 4a element 730, Figure 4b element 740, Figure 1 elements 613, 614.**
a processor configured to identify, using a processor, promotions offered to said first consumer, by retrieving from a central database system in which consumer identifications are associated with promotion offers data for promotions previously offered to consumers, first consumer promotions offer data associated with said first consumer identification for promotions previously offered to said first consumer;	**Page 6 lines 19-22; Page 15 line 29 through Page 16 line 6; Figure 4a element 730, Figure 4b element 740, Figure 1 element 615; Page 9 lines 16-19; Figure 1 element 613, 614.**
a processor configured to determine a first demographic characteristic of said first consumer, based at least in part upon said first consumer promotions offer data; and	**Page 9 lines 12-19; Figure 1 elements 611, 615, 616, 617; Figure 3b element 720; Page 14 lines 24-25; Figure 3a element 710e; Figure 7 element 6200.**
a processor configured to determine a time at which to transmit to said first consumer a subsequent promotion offer, based at least in part upon said first consumer demographic characteristic.	**Page 9 lines 19-21; Figure 1 elements 611, 613, 615, 616, 617; Page 11 lines 26-30; Figure 2 elements 644, 646; Page 16 lines 1-2;**

	Figure 4a element 730; Page 19 lines 11-12; Figure 7 element 6300; Page 14 lines 28-29; Figure 3a element 710e.
88. A system, comprising: a promotion interaction site configured to receive, using a request input device, a first consumer target parameter;	Page 11 lines 10-18; Figure 1 elements 610, 620, 640, 643, 646, 680, 682.
an identification input device at a vendor interaction computer configured to receive a first consumer identification for a first consumer;	Page 8 lines 10-11; Figure 1 element 638; Figure 6 element 6100.
a central database comprising a consumer identification table and a promotion table;	Page 15 line 29 through Page 16 line 6; Figure 4a element 730, Figure 4b element 740, Figure 1 elements 613, 614.
a processor configured to identify, using a processor, promotions offered to said first consumer, by retrieving from a central database system in which consumer identifications are associated with promotion offers data for promotions previously offered to consumers, first consumer promotions offer data associated with said first consumer identification for promotions previously offered to said first consumer;	Page 6 lines 19-22; Page 15 line 29 through Page 16 line 6; Figure 4a element 730, Figure 4b element 740, Figure 1 element 615; Page 9 lines 16-19; Figure 1 element 613, 614.
a processor configured to determine a first demographic characteristic of said first consumer, based at least in part upon said first consumer promotions offer data;	Page 9 lines 12-19; Figure 1 elements 611, 615, 616, 617; Figure 3b element 720; Page 14 lines 24-25; Figure 3a element 710e; Figure 7 element 6200.
a processor configured to determine if said first consumer target parameter matches said first demographic characteristic of said first consumer; and	Page 11 lines 26-30; Figure 2 elements 644, 646.
a processor configured to determine a time at which to transmit to said first consumer a subsequent promotion offer, based at least in part upon said first consumer demographic characteristic.	Page 9 lines 19-21; Figure 1 elements 611, 613, 615, 616, 617; Page 11 lines 26-30; Figure 2 elements 644, 646; Page 16 lines 1-2; Figure 4a element 730; Page 19 lines 11-12; Figure 7 element 6300; Page 14 lines 28-29; Figure 3a element 710e.

E.   **Amendment in Response to the Rejections of Claims 1-65**

In response to the rejections of claims 1-65 in the office action, the applicant has cancelled claims 1-65 and added new claims 66-88. In the preceding section, the applicant has submitted evidence proving that prior art reference Kepecs is not 35 USC 102(e) prior art to the subject application.

Assuming arguendo that Kepecs is 35 USC 102(e) prior art to the subject application, Kepecs does not anticipate claims 66-88 because Kepecs does not disclose "determining a time at which a subsequent promotion is to be offered to said consumer based upon said demographic characteristic of said consumer", which is either recited or defined in every independent claim in the subject application.

Kepecs' abstract discloses:

Techniques for generating and making incentive offers and promotions to consumers to influenced the consumers' purchasing behavior. Offers are customized for each individual consumer based on the particular consumer's purchase history information (or shopping history) and the consumer's response to the offers.

Kepecs discloses varying the timing of future promotions, based on a consumer's purchase or non-purchase of an item in which the consumer has received a promotion. See column 29 lines 23-27:

The "wait after failure" parameters tells the tactic state machine, as implemented by YME module 120, to refrain from generating any new offers after a failed offer until the time specified by the "wait after failure" parameter has been exceeded.

See also column 29 line 59 through column 30 line 3:

The "wait after success" parameter instructs the tactic state machine to wait for a specified period of time before making another offer. The amount of time specified by the "wait after success" parameter may depend on the campaign designer's sense of how frequently the consumer is likely to use up a product or make another purchase of the product. For example, if the campaign designer, using his judgment, believes that the 100 gallon drum of the previously purchased laundry detergent will last the user for a period of 6 months, the "wait after success" parameter may be set to 6 months. Accordingly, no new offer on a laundry detergent will be made to the consumer for at least six months.

However, such disclosures do not teach or suggest "determining a time at which a subsequent promotion is to be offered to said consumer based upon said demographic characteristic of said consumer".

Kepecs discloses varying promotions based upon a consumer's demographic characteristics. See, for example column 26 lines 8-36, which discloses offering incentives to purchasers of baby supplies, see also column 22 lines 33-35 and column 24 lines 9-14. However, these disclosures do not include determining the timing of a subsequent promotion.

For the reasons presented above, Kepecs does not disclose "determining a time at which a subsequent promotion is to be offered to said consumer based upon said demographic characteristic of said consumer", which is either recited or defined in every independent claim in the subject application. Therefore, Kepecs does not anticipate claims 66-88.

F.   **Conclusion**

Kepecs does not disclose limitations in every independent claim presented in the current amendment. Moreover, the subject application's prefiling documents antedate Kepecs, so Kepecs does not qualify as 102 (e) prior art with respect to the subject application. Therefore, the rejections of claims 1-65 under 35 USC 102(e) as being anticipated by Kepecs, and made unpatentable by Kepecs, are improper and should be withdrawn.

The applicant believes that claims 66-88 are in condition for allowance.

Respectfully,

Date: 2/26/2010   /BruceMargulies#64,175/

                                   Bruce Margulies, Reg. No. 64,175

                                   Attorney of Record

BTM

Printed: February 26, 2010 (11:17am)

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Neifeld Docket No: PIP-69A-KATZ

Application/Patent No: 09/776,714   USPTO CONFIRMATION NO: 2896

File/Issue Date: 2/6/2001

Inventor/Title: Gary M. KATZ/Method and System for Timing Promotions Based on a Prior Receipt of Promotions

Examiner/ArtUnit: ALVAREZ/3688

ENTITY STATUS: Large

Priority claims: None

EXHIBIT LIST

Attachment 1: a copy of a November 21, 2000 email from John Conroy, a patent attorney at Oblon, Spivak, McClelland, Maier & Neustadt, P.C., the firm that filed the subject application, to John Halak, vice president of legal affairs for Catalina Marketing Corporation, the assignee of the subject application, which further contains email attachments comprising a draft of the written description, claims, and drawings [the November 21, 2000 specification]. The November 21, 2000 specification is are also included in Attachment 1. The November 21, 2000 specification discloses every limitation in every new claim (claims 66-88) in the subject application. The November 21, 2000 specification antedates Kepecs.

Attachment 2: a copy of an email from Carol Chapman (now Carol Warren) to John Conroy, Robert Mattson, and Rick Neifeld December 4, 2000 with an invention disclosure of another invention for consideration of inclusion with the present application. This email was forwarded from Carol Warren to Bruce Margulies February 5, 2010.

Attachment 3: a copy of an email from John Conroy to Gary Katz and John Halak dated December 11, 2000 to set up a telephone conference to discuss the two inventions.

Attachment 4: a copy of an email from Robert Mattson to Rick Neifeld dated December 15, 2000 noting that Inventor Gary Katz would be out of town from December 16, 2000 until January 2001.

Attachment 5: a copy of an email from Carol Chapman to Gary Katz dated December 15, 2000 requesting dates that he is available in January 2001.

Attachment 6: a copy of an email from John Conroy to Carol Chapman dated December 15, 2000 suggesting the conference call take place January 3-5, 2001.

Attachment 7: a copy of an email from John Conroy to Gary Katz et al. Dated January 22, 2001 noting that the conference call has been rescheduled for January 23, 2001.

Attachment 8: a copy of an email from John Conroy to Carol Chapman dated January 23, 2001 with a copy of the subject application and associated documents for execution. This email was forwarded from Carol Warren to Bruce Margulies February 5, 2010.

Attachment 9: a copy of an email from Carol Chapman to Gary Katz and Tony Bailey dated January 29, 2001 with a renamed and corrected copy of the subject application. This email was forwarded from Carol Warren to Bruce Margulies February 5, 2010.

Attachment 10: a copy of an email from John Conroy to Carol Chapman dated January 29, 2001 noting that the titles in the documents to be executed have been changed as well.

Attachment 11: a copy of an email from John Conroy to Carol Chapman dated January 31, 2001 thanking Carol Chapman for her email from that afternoon noting that she had sent the executed documents that day.